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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,498	12/14/2001	William E. Pence	3652/0K015	5619
7278	7590	06/22/2005	EXAMINER	
DARBY & DARBY P.C. P. O. BOX 5257 NEW YORK, NY 10150-5257			HEWITT II, CALVIN L	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 06/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/017,498

Applicant(s)

PENCE ET AL.

Examiner

Calvin L. Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2005.  
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-22 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-9 and 11-22 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

***Status of Claims***

1. Claims 1-9 and 11-22 have been examined.

***Response to Arguments/Amendments***

2. Applicant equates “transparently” to “without notifying a user”. While, this a valid definition, “transparently” also has other meanings (see webopedia and Microsoft Press Computer Dictionary definitions) therefore, as Applicant’s Disclosure is silent regarding “... one application to use files created by another is transparent if the user encounters no difficulty in opening, reading, or using the second program’s files” (Microsoft Press Computer Dictionary). In order to overcome the 112 rejection to “transparently transmitting” Applicant is required to change the language to “without notifying the user”. However, Applicant does not have support nor suggest renewing or updating a license without notifying a user therefore, in order to overcome the applied 112 rejection, Applicant must remove language such as “transparently” or “without notifying a user”.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-9 and 17-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claims 1 and 19-22, Applicant equates “transparently” to “without notifying a user”. While, this a valid definition, “transparently” also has other meanings (see webopedia and Microsoft Press Computer Dictionary definitions) therefore, as Applicant’s Disclosure is silent regarding one application using files created by another and the user encountering no difficulty in opening, reading, or using the second program’s files (Microsoft Press Computer Dictionary). In order to overcome the 112 rejection to “transparently transmitting” Applicant is required to change the language to “without notifying the user”. The Applicant’s Specification is also silent regarding the following: “renewing the parameters transparently” (claims 1, 19, 20 and 22) “update said license file parameter transparently” (claims 17 and 18) (note the Applicant also does not have support for renewing or updating “without notifying a user”).

Claims 2-9 and 11-18 are also rejected as they depend from claims 1 and 21, respectively.

5. Claims 1-9 and 17-20 and 22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The Applicant's Specification is silent regarding the following: "renewing the parameters transparently" (claims 1, 19, 20 and 22) "update said license file parameter transparently" (claims 17, 18 and 22). Further the Specification does not provide one of ordinary skill with the necessary data for implementing the Applicant's system regarding transmitting a license file "transparently", particularly in light of the Applicant's teachings which suggest to one of ordinary skill that the user has or explicit knowledge of the existence or at least knowledge of the functionality of the license with respect to the content (Specification, figures 2A-3B). In addition it is not clear to one of ordinary skill whether the user never has knowledge of the license, is not informed of the specific download, or somewhere in-between.

Claims 2-9 are also rejected as they depend from claim 1.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-9 and 17-20 and 22 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. The Applicant's Specification is silent regarding the following: "renewing the parameters transparently" (claims 1, 19, 20 and 22) "update said license file parameter transparently" (claims 17, 18 and 22). Further the Specification does not provide one of ordinary skill with the necessary data for implementing the Applicant's system regarding transmitting a license file "transparently", particularly in light of the Applicant's teachings which suggest to one of ordinary skill that the user has or explicit knowledge of the existence or at least knowledge of the functionality of the license with respect to the content (Specification, figures 2A-3B). In addition it is not clear to one of ordinary skill whether the user never has knowledge of the license, is not informed of the specific download, or somewhere in-between.

Claims 2-9 are also rejected as they depend from claim 1.

b. Claims 11-18 are directed to a system. However, claim 21 from which they depend is an apparatus. And, while claim 21 comprises various system components (e.g. content provider system, user system),

dependent claims 11-18 do not refer back to one of these components (e.g. the content provider system of claim 21).

c. Claims 1, 19, 20 and 22 recite conditional language. Claims 1, 19, 20 and 22 detail processing "if the parameters in the license file differ from the corresponding parameters maintained by the provider system", however they do not provide for how the method or apparatus is to perform if the parameters are *not* different. Therefore, the scope of these claims is unclear to one of ordinary skill ("The reason is simply that during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed.... An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous." (*In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989))).

Claims 2-9 are also rejected as they depend from claim 1.

d. Claim 1 recites the limitation "content item requested by a user" (emphasis added) in lines 2 and 3, and the limitation "the license file parameters maintained by the provider system" in lines 13 and 14. Claim 1 Claims 19, 20 and 22 recite similar limitations. There is insufficient antecedent basis for this limitation in the claim.

Claims 2-9 are also rejected as they depend from claim 1.

e. Claim 12 recites a user system "for receiving user input and providing said user input to said communication application, said license storage and said content storage". It is not clear to one of ordinary skill the meaning of "...said license storage and said content storage" in the context of the claim.

Claims 13-18 are also rejected as they depend from claim 12.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-9 and 11-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krishnan et al., U.S. Patent No. 6,073,124 in view of Coley et al., U.S. Patent No. 5,790,664.

As per claims 1-9 and 11-22, Krishnan et al. teach a licensing system comprising:



- creating a license file for individual content items, at a file server (figure 3), having one or more parameters for a content item requested by a user and transmitting the license and content to said user (abstract; figures 4, 9 and 12; column 4, lines 45-55; column 7, lines 20-43; column/line 9/30-10/40; column 10, lines 41-55; column/line 17/45-18/35; column 18, lines 45-63; column/line 22/23-23/40)
- parameters that include date, user's country, monetary value value on account, user's technical information, type of content to be downloaded, number of times content has been downloaded and grace period (column 18, lines 45-63; column/line 22/23-23/40)
- storing content on a provider system content server (figure 3), storing user license files in a registry (figure 5), and storing downloaded content in a user database (figure 5)
- a user system comprising a client application for receiving user input (figure 5)

Regarding "transparency", by Applicant's own admission the transparent transmission of computer data is old and well known and not a distinguishing feature between Applicant's claims and the state of the art (Appeal Brief, pages/line 8/4-9/20). Therefore, an obvious modification to the teachings of Krishnan et al. would be to transmit computer data such as a license file

transparently in order to provide a user-friendly computing environment (Appeal Brief, page 8, lines 7-15, in reference to Applicant cited U.S. Patent No. 6,519,624, column 2, lines 6-11). However, Krishnan et al. do not specifically recite transparently renewing or updating parameters in a license file. Coley et al. teach a process for renewing and updating a license transparently (abstract; column 4, lines 22-52). Specifically, Coley et al. teach comparing one or more parameters in a license file to one or more parameters maintained by a provider system, using a subscription management system for monitoring, maintaining and comparing, license file parameters, to determine whether or not a user is allowed access to content and if the compared parameters differ allowing continued access to the content in accordance with the license parameters of the provider system (column 8, lines 15-54; column 15, lines 34-63; column/line 15/62-16/11; column 19, 25-44). Coley et al. also teach license files where a single file is created for a plurality of items (column 13, lines 12-27). Therefore, it would have been obvious to one of ordinary skill to modify the licensing system of Krishnan et al. with the teachings of Coley et al. in order to allow for the more efficient registration, enabling or re-enabling user license information ('664, column 3, lines 50-67) and prevent users from extending trial or rental usage of software ('124, figures 9 and 12, column 7, lines 16-44) by tampering with a user system clock ('664, column 19, lines 25-44).

***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Ross et al. teach an apparatus for electronic licensing
- Misra et al. disclose distributing licenses to client systems using license packs that contain a plurality of licenses

10. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (571) 272-6712.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
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Washington, D.C. 20231

or faxed to:

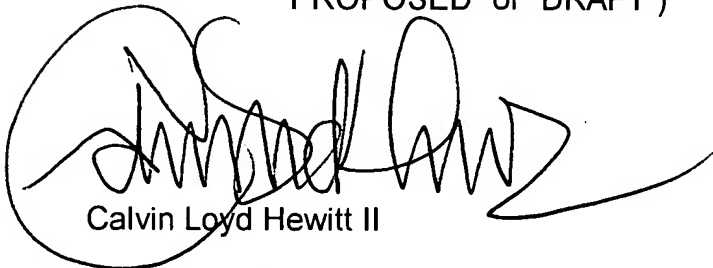
Art Unit: 3621

(703) 872-9306 (for formal communications intended for entry and  
after-final communications),

or:

(571) 273-6709 (for informal or draft communications, please label

"PROPOSED" or "DRAFT")

A handwritten signature in black ink, appearing to read "Calvin Hewitt II", is written over a circular stamp. The signature is fluid and cursive, with a large loop at the end.

Calvin Loyd Hewitt II

June 17, 2005